



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,000	12/01/2000	Ross Ward Comer	MS#39124.2/40062.117USRE	2267

7590

09/06/2002

Homer L. Knearl  
Merchant & Gould P C  
PO Box 2903  
Minneapolis, MN 55402-0910

EXAMINER

FEILD, JOSEPH H

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/728,000

Applicant(s)

COMER ET AL.

Examiner

JOSEPH H FEILD

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Page 4 v. 5 for 2

***Reissue Applications***

1. This office action is responsive to applicant's response filed **June 6, 2002**, which in turn was responsive to an ex parte Quayle action. Unfortunately, the case is not in condition for allowance. The examiner regrets the inconvenience caused to applicant for the delay in prosecution.

2. It is noted that applicant, in the response filed **February 6, 2002** (paper #11), at page 3, states, "Submitted herewith is a substitute consent of the assignee to the reissue application containing the frame and reel number of the originally recorded assignment as requested by the Examiner". However, while applicant did file a Statement Under 37 CFR 3.73(b) which identifies the reel and frame number at which is recorded the assignment, no actual consent has been received. Therefore:

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

3. The reissue oath/declaration filed with this application is defective because:

(1) the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Art Unit: 2176

Applicant attempts to recapture subject matter surrendered during prosecution of the patent application upon which the present reissue is based. Thus, it appears that no reissuable error has been identified.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. The supplemental oath/declaration must include a different specific error that qualifies as a reissuable error.

4. Claims 1-60 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Further regarding the issue of recapture, in new claim 39 (and similarly in claims 57 and 59), the limitation that broadens the claim is as follows: "identifying a list of completed data items from a search region with the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero, and (4) cells within the same row as the active cell and within a range of N cells from the active cell, wherein N is an integer".

The corresponding limitation in claim 1 of the patent is as follows: "identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells".

The language that constitutes broadening is the deletion of the limitations "bordered by empty cells" and "contiguous data-containing cells encompassing said active cell". It is noted that in prosecution of the application (08/658,798), which matured into the patent (5,845,300), the claims initially before the examiner did not include the "identifying" step. It is clear from the record that the claims were amended to overcome the prior art rejection. In amendment B of application 08/658,798 (paper #8), applicant amended the claims to include the "identifying" step in addition to other limitations. At pages 13-14 of the same amendment, applicant identified the newly added limitation in bold-faced lettering, and stated that "none of the references cited, alone or in combination, describe identifying a list of completed data items from a search region within a spreadsheet as recited by amended claim 1". Applicant further elaborated on this limitation as compared to the references relied upon by the examiner in rejecting the claim.

***Allowable Subject Matter***

5. Claims 1-60 contain allowable subject matter based on the prior art of record. Thus, once the other errors discussed above are corrected, and if applicant overcomes the recapture bar, the case can pass to issue.

With respect to claims 1-25, 27-38, the prior art fails to teach "identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells" (as in claims 1, 19, 23, 33) in combination with the remaining limitations.

With respect to claim 26, the prior art fails to teach “selecting an active cell within a search region comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells”, “enabling said active cell to receive a partial data entry and a suggested completion”, and “accepting said suggested completion” in combination with the remaining limitations.

With respect to claims 39-56, the prior art fails to teach “identifying a list of completed data items from a search region within the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero, and (4) cells within the same row as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero” in combination with the remaining limitations.

With respect to claims 57-58, the prior art fails to teach “identifying a list of completed data items from a search region within the spreadsheet, said search region including cells within the same column as the active cell” in combination with the remaining limitations.

With respect to claims 59-60, the prior art fails to teach “identifying a list of completed data items from a search region within the spreadsheet, said search region including cells within the same row as the active cell” in combination with the remaining limitations.

### ***Response to Arguments***

6. Applicant's arguments filed February 6, 2002, with respect to the issue of recapture have been fully considered but they are not persuasive.

At pages 4-7, applicant argues that the reissue claims are not barred from the recapture rule. Applicant cites Ball Corp. v. U.S., USPQ 289, 295 (Fed. Cir. 1984), at page 4, and concludes, "Thus, the determination that must be made in this instance is whether the reissue claims are of the same or broader scope than the claims of the original application. However, the US CAFC determined, in Pannu v. Storz Instruments Inc., 59 USPQ2D 1597, decided July 25, 2001, "On reissue, [applicant] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections" (page 1601). Thus, it is the examiner's opinion that the Recapture Rule does apply.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2176

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



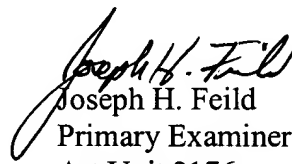
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Feild whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238	<b>(After Final Communication)</b>
(703) 746-7239	<b>(Official Communication)</b>
(703) 746-7240	<b>(For Status Inquiries, draft communication)</b>

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Joseph H. Feild  
Primary Examiner  
Art Unit 2176

9/5/02